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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,373	05/19/2005	Hidetaka Oka	EL/2-22798/A/CGJ 130/PCT	9344
324 7590 08/21/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER JOHNSON, CONNIE P	
			ART UNIT 1752	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,373	Applicant(s) OKA ET AL.	
	Examiner Connie P. Johnson	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The remarks and amendment filed 5/17/2007 have been entered and fully considered.
2. Claims 1-3, 6 and 11-13 are presented.
3. Claim 13 is new.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushirogouchi et al., U.S. Patent No. 5,691,101 in view of Wolleb, U.S. Patent No. 6,087,492.

Ushirogouchi teaches a photosensitive composition comprising a compound that generates acid when irradiated with light and an acid crosslinked resin (col. 2, lines 32-33). The composition may also comprise glycidyl-methacrylate (monomer) and an epoxy resin (see col. 6, lines 53 and 65-67). The composition may also comprise an epoxy resin that is modified to be alkali-soluble with acrylic acid or a carboxylic acid derivative (col. 7, lines 1-4). The reference also teaches that the photosensitive composition is coated onto a substrate (col. 3, lines 12-14). Ushirogouchi also teaches dyes and pigments in the photosensitive composition. Suitable pigments (colorants)

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include phthalocyanines (col. 9, line 3). Ushirogouchi does not specifically teach phthalocyanine green colorant in the photosensitive composition.

However, Wolleb teaches a recording layer comprising a substituted phthalocyanine. The recording layer is a photosensitive layer. The substituted phthalocyanines comprise divalent copper Cu(II) as the divalent metal wherein the X substituent is hydrogen and Y is C₁-C₂₀ alkyl (n-octyl) (see col. 3, lines 1-43). Line 43 specifically teaches substitution of the phthalocyanine by an n-octyl group as in instant claim 2. Wolleb teaches phthalocyanines produce excellent results in recording medium (col. 9, lines 11-12). It would have been obvious to one of ordinary skill in the art to use the phthalocyanine of Wolleb in the photosensitive composition of Ushirogouchi to enhance light shielding properties of the photosensitive composition as taught by Ushirogouchi.

6. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al., U.S. Patent No. 4,789,620 in view of Wolleb, U.S. Patent No. 6,087,492.

Sasaki teaches a photosensitive composition comprising an alkali-soluble monomer or oligomer (col. 5, lines 45-60). The composition also comprises a photoinitiator (see abstract). Sasaki also teaches an epoxy compound (col. 4, line 50). The reference also teaches that the composition comprises a vinyl monomer component (col. 7, lines 3-4). The composition also comprises a phthalocyanine green pigment (see examples in columns 12-16). Sasaki does not teach that the phthalocyanine green colorant has the structure as in the formula of instant claim 1.

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However, Wolleb teaches a recording layer comprising a substituted phthalocyanine. The recording layer is a photosensitive layer. The substituted phthalocyanines comprise divalent copper Cu(II) as the divalent metal wherein the X substituent is hydrogen and Y is C₁-C₂₀ alkyl (n-octyl) (see col. 3, lines 1-43). Line 43 specifically teaches substitution of the phthalocyanine by an n-octyl group as in instant claim 2. Wolleb teaches phthalocyanines produce excellent results in recording medium (col. 9, lines 11-12). It would have been obvious to one of ordinary skill in the art to use the phthalocyanine of Wolleb in the photosensitive composition of Sasaki because Wolleb teaches the phthalocyanine green colorants that are used in photosensitive layers.

Response to Arguments

7. Applicant's arguments filed 5/17/2007 have been fully considered but they are not persuasive.
8. Applicant argues that the monomer groups in Ushirogouchi are comprised in acid-crosslinkable resins and are therefore not the polymerizable monomer as claimed.

Applicant is directed to claim 1 of the instant invention, wherein the composition claim discloses that a photosensitive layer comprises a polymerizable monomer. The glycidyl methacrylate is a polymerizable monomer in the epoxy resin. Further, applicant is directed to page 8 of the specification, third paragraph wherein applicant discloses that the monomers of the photosensitive layer may be inclusive in a mixture with other components, specifically resin components. Ushirogouchi teaches this same feature.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Connie P. Johnson whose telephone number is 571-272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Connie P. Johnson
Examiner
Art Unit 1752

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Cynthia H. Kell